

These species elections are made with the understanding that they are required for examination purposes only and that all species will be considered should the generic claim be found to be allowable.

Remarks

In response to the restriction requirement, Applicants have elected Group I and species of a proteinaceous binding domain that is an antibody heavy chain and a target material that is a human neutrophil elastase. Claims 1-19 are embraced by these elections. Applicants make these elections with traverse.

Applicants traverse the restriction requirement on the basis that Group I and Group II are not independent and distinct. The inventions are not independent, as required under 35 U.S.C. section 121, at least because Group II claims depend from Group I claims. The inventions of Group I and Group II are both methods. MPEP section 806.04 provides an example of two methods that are independent inventions: "(A)Two different combinations, not disclosed as capable of use together, having different modes of operation, different functions or different effects are independent." Groups I and II do not fall within this example because they can be used together; indeed, Group I is a step within Group II.

The dependence of Groups I and II is further illustrated by comparing them to the specific example of independent method inventions the MPEP goes on to provide: "A process of painting a house and a process of boring a well would be a second example." Unlike this specific example, Groups I and II are not independent and distinct inventions. Rather they are, by definition, dependent inventions. Accordingly, the restriction requirement should be withdrawn.

Applicants also traverse the election of species requirement at least because the Examiner has not complied with the requirements of MPEP section 809.02(a) for an election of species requirement. Before an Applicant can be required to make an election of species, the Examiner must: "(A) Identify generic claims or indicate that no generic claims are present." and "(B) Clearly identify each (or in aggravated cases at least exemplary ones) of the disclosed species, to which claims are restricted." The Examiner has not met either of these requirements for a restriction requirement.

The Examiner has not identified each of the disclosed species of eukaryotic cells or antibody heavy chain binding domain amino acid sequences to which claims are restricted nor has he grouped claims in accordance with the species to which they are restricted, as required under MPEP section 809.02(a). Applicants have attempted to comply with the election of species requirement. In the absence of such guidance from the Examiner, however, Applicants have not been able to make all the elections requested by the Examiner.

For example, Applicants have not elected a specific amino acid sequence corresponding to the elected antibody heavy chain binding domain, and Applicants have not elected a specific species of eukaryotic cell because the application does not disclose either. Applicants respectfully submit that their bona fide inability to make such elections illustrates the improper nature of the election of species requirement.

Indeed, election of species practice finds its basis in 37 C.F.R. section 1.146 "Election of species." That section simply does not apply to the present situation because it contemplates "an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby." *See also* section 1.141 ("more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form (§ 1.75) or otherwise include all the limitations of the generic claim.").

Applicants respectfully submit that the Examiner has not met the requirements for an election of species requirement because election of species practice does not apply to the present situation. The Examiner has not identified generic and corresponding species claims, nor has the Examiner identified particular disclosed species embraced by at least some of the asserted genera. Accordingly, while Applicants have made a bona fide attempt to comply with the election of species requirement, they have not been able to elect a specific disclosed antibody heavy chain amino acid sequence or a specific disclosed eukaryotic cell.

Having made this election and notwithstanding the above, Applicants expressly reserve the right to file one or more divisional applications on the subject matter of the claims as originally filed.

Respectfully submitted,
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